

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL J. GIAMATI

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Appeal No. 98-2889  
Application 29/022,106<sup>1</sup>

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ON BRIEF

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Before CALVERT, STAAB and WALTZ, *Administrative Patent Judges*.  
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of the following design claim:

The ornamental design for a heavy duty brush assembly housing unit with an integral attachment

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<sup>1</sup> Application for patent filed April 29, 1994.

leg as shown and described.

No references have been relied upon by the examiner in rejecting the claim.

The appealed claim stands rejected under 35 U.S.C. § 171 as lacking ornamentality because the design is for a device that is hidden from view in the final stage of its commercial life.

The appealed claim stands further rejected under 35 U.S.C. § 171 as being primarily functional rather than ornamental in use.

*The Hidden from View Rejection*

According to the examiner, a prima facie case of lack of ornamentality has been established in this case because references cited during prosecution clearly show that articles of the type claimed herein are hidden from view in their final use.<sup>2</sup>

Appellant does not dispute that articles of the type claimed herein are hidden from view in their final use.

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<sup>2</sup> As an example, the examiner directs our attention to Fig. 1 of U.S. Patent 4,136,295.

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Appellant maintains, however, that the declarations of Mr. Michael J. Giamati, the sole inventor, and Mr. Gary G. Garcia, manager of product support and customer service for the assignee of the present invention, establish "that the claimed article was designed for sale and display, and that the appearance of the article had a substantial influence on the design and ornamentality of the article [such that] . . . an adequate showing of ornamentality has been provided" (brief, page 2).

The examiner contends, however, that appellant has not shown that the appearance of the article was a matter of concern at some point in the life of the article.

In his declaration, inventor Michael J. Giamati declares that he "designed the brush assembly housing claimed in the captioned application to have a 'heavy duty' look and feel." For his part, assignee's manager Gary G. Garcia declares, on information and belief, that (1) "at least some customers have a perception that a brush assembly having a housing with a 'heavy duty' appearance, will perform better," (2) "this perception is at least partly based on the appearance of the brush assembly housing," and (3) "the 'heavy duty' appearance

. . . as claimed in the captioned application, was a factor in at least some customer's decisions to replace modular brush assemblies having [dissimilar] appearances . . . ."

When an article is hidden from view in the final stage of its commercial life it is reasonable to presume, as a general rule, the absence of ornamentality. *In re Webb*, 916 F.2d 1553, 1557, 16 USPQ2d 1433, 1435 (Fed. Cir. 1990). Inquiry must extend, however, to whether at some point in the life of the article an occasion arises when the appearance of the article becomes a "matter of concern." *Id.* Our reading of appellant's declaration evidence, particularly those portions noted above, leaves us with little doubt that the appearance of the article in question was indeed a "matter of concern" prior to its final use in that, on those occasions when the article was viewed by prospective buyers its appearance was purposefully intended to favorably influence prospective buyers to purchase same. The examiner is not understood to view the declarations otherwise.<sup>3</sup> As such, we consider

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<sup>3</sup> Indeed, the examiner states that "[he] will concede that Mr. Garcia's affidavit [sic, declaration] establishes that during the period of its visibility, the appearance of the claimed design was a 'matter of concern'" (answer, page

appellant's evidence to be sufficient to overcome the presumption of lack of ornamentality raised by the circumstance that the article is hidden from view in its final stage of use. We therefore will not sustain the examiner's "hidden in use" rejection.

*The Primarily Functional Rejection*

Looking at the examiner's second rejection under 35 U.S.C.

§ 171, the examiner states that "[t]he housing claimed in the instant application is also the subject of U.S. Patent No. 5,479,060. The few features of the housing that are discussed in this patent are functional in nature" (answer, page 5). Implicit in the above is the examiner's position that the noted circumstances are sufficient to establish that the claimed design is primarily functional rather than ornamental in use.

To qualify for design patent protection, a design must have an ornamental appearance that is not dictated by function alone. *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456,

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1460, 43 USPQ2d 1887, 1890 (Fed. Cir. 1997). When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456, 43 USPQ2d 1953, 1956 (Fed. Cir. 1997); *L. A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993).

Here, declarant Giamati, the sole inventor, states that he "designed the brush assembly housing claimed in the captioned application to have a 'heavy duty' look and feel." Giamati also states that "a functionally equivalent brush assembly having a 'light duty' appearance could be designed having a substantially different appearance than the claimed design." Declarant Giamati adds that "a functionally equivalent brush assembly having a 'heavy duty' appearance could be designed having a substantially different appearance than the claimed design such as, for example, by configuring the attachment leg as an aluminum bracket integrally attached to the brush housing, as well as other configurations . . . ."

We do not share the examiner's apparent belief that the

existence of appellant's corresponding utility patent is controlling on the functionality issue raised here. Rather, the existence of the utility patent is merely one factor to be considered with respect to the issue at hand. *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d at 1456, 43 USPQ2d at 1956. In the present instance, the inventor declares that the article was designed to have a heavy duty appearance. Also noteworthy is appellant's statement in the declaration that a functionally equivalent article having an aluminum attachment leg could be designed. U.S. Patent No. 4,136,295, of record, apparently shows at element 82 one such attachment leg used for mounting a modular brush housing unit. If used in conjunction with appellant's housing unit, a different design would result. In addition, we note the BFGoodrich Report No. 68-04-714K publication made of record by appellant. On page 24 of that publication, Figure 29 shows what appears to be a block-like brush housing unit 5 having a design that is markedly different from the claimed design. Weighing all the above factors, we conclude that the claimed design is not merely functional. We therefore will not sustain the

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examiner's rejection of the appealed claim on this basis.

*Summary*

The decision of the examiner is reversed.

*REVERSED*

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

Mary Ann Tucker  
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